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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/364,731 07/30/99 KATZ

R 244/165

EXAMINER

LM01/0509

LYON & LYON LLP  
DAVID B MURPHY  
633 WEST FIFTH STREET  
47TH FLOOR  
LOS ANGELES CA 90071

WOO, S

ART UNIT

PAPER NUMBER

2743

DATE MAILED:

05/09/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/364,731

Applicant(s)  
Katz

Examiner  
Stella Woo

Group Art Unit  
2743



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 29-48 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 29-48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 29-37 recite a "telephone system of a type controllable by travel cards" and claim 38 recites a "method of handling telephone calls by use of travel cards." However, applicant's specification contains no teaching or suggestion of using "travel cards," which play the central role in the system of Marshall. A telephone travel card is issued by a telephone company to enable a caller to place long distance calls over any phone and to charge the call to the account of the accountholder. The travel card authorization takes place at the telephone switching facility such that the call is not completed through the telephone network unless certain conditions are met. In contrast, applicant's specification describes the use of a credit card to authorize a transaction, such as mail order transaction or lottery participation, which takes place over an already completed telephone connection. A travel card is used to authorize telephone call completion. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are completed to applicant's telephone-interface

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system without any prior qualification based on the credit card or lottery identification data. Therefore, applicant's credit card or lottery ticket cannot be considered as a "travel card" which carries out a specific function in the telephony art.

Claims 29-37, 39-47 recite a "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing" as recited in claims 29-37, 39-47 since in applicant's system, the call is completed through the switching facilities (communication facility C, ACD, switch 21) irrespective of the caller's standing.

Claims 38 and 48 recite "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled

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by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the step of "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing."

Applicant's disclosure fails to provide support for the voice response device which is able to "make a call through the telephone system," "prevent a caller using a travel card to make a call through the telephone system," "leave a message for at least one subsequent caller using a travel card to make a call through the telephone system," and "permit a caller using a travel card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a travel card customer" as recited in claims 30 and 40.

Applicant's disclosure fails to provide support for performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time" as recited in claims 31 and 41. Applicant's system provides for a use-rate calculator for determining and limiting the number of successful uses by a caller, not the number of failed attempts.

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Applicant's disclosure does not provide support for "a data storage server means...capable of access by travel card customers of the telephone system to provide current billing information to travel card customers" as recited in claims 32 and 42 or "a voice response means being...capable of providing an oral report of current account status to travel card users" as recited in claims 33 and 43.

3. Claims 39-48 of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. 5,790,636.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 5,790,636 because it does not contain all the material limitations of the patent claim as required by 35 USC 135 (b), namely, the use of a travel card for controlling the telephone system. Accordingly, an interference cannot be initiated based upon these claims.

4. Claims 29-48 of this application has been copied by the applicant from U. S. Patent No. 5,790,636. This claim is not patentable to the applicant because they are not supported by applicant's original disclosure.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

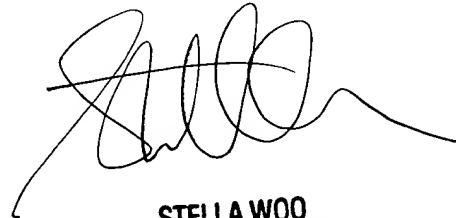
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**or faxed to:**

(703) 308-6306 or (703) 308-6296.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:30 a.m. until 2:00 p.m. on Monday, Wednesday, Friday, and from 6:30 a.m. until 10:30 a.m. on Tuesday and Thursday.



**STELLA WOO  
PRIMARY EXAMINER**

May 5, 2000